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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1941

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No. 968  
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**MASSACHUSETTS HAIR & FELT COMPANY,**

Petitioner,

vs.

**B. F. STURTEVANT COMPANY,**

Respondent  
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**REPLY BRIEF OF PETITIONER**  
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There are special and important reasons which justify the granting of review on writ of certiorari in this case.

In this case as in the *Bassick* and *Lincoln* cases,\* the patentee improved one element of an old combination and in his patent claimed the old combination with the improved element incorporated therein. This case differs from the *Bassick* and *Lincoln* cases, however, in that the defendant here is using a structure which embodies all of the elements of the claims and is not merely selling old

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\**Bassick Mfg. Co. v. R. M. Hollingshead Co.*, 298 U. S. 415,  
*Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545.

elements knowing and intending that they be used with the other elements of the claims.

The Court of Appeals was of the opinion that this difference is of controlling importance because it said (R. V. III, p. 828):

“The reason we do not consider these cases to be in point is that Hagen, unlike the patentees in the *Lincoln* and *Bassick* cases, made no attempt to cover in his patent, which is a combination one, all of the separate parts of the combination including those which were unpatented and old in the art. That is, he did not attempt by his patent to prevent others from using any form of vane controlled centrifugal fan, but attempted only to prevent others from using such a fan, with inlet vanes substantially similar to his.”

In so ruling, the Court of Appeals has either rendered a decision in conflict with the decisions of this Court in the *Bassick* and the *Lincoln* cases, or else it has decided a question of federal law which has not been and which should be settled by this Court and has decided it in a way probably in conflict with the applicable decisions of this Court and certiorari should be granted.

We have assumed from the date of the *Bassick* and *Lincoln* decisions that they were applicable to all cases involving patents in which the patentee claimed an old combination, even though his contribution was merely an improvement in one element thereof, and we have assumed that the decision of the Court of Appeals is in direct conflict with these cases which would warrant the issuance of the writ of certiorari. The Court of Appeals has, however, found something in the *Lincoln* and *Bassick* decisions which has led the Court of Appeals to its conclusion that

the *Bassick* and *Lincoln* cases apply only when a patentee seeks to control commerce in unpatented articles which are elements only of the claims and which do not in and of themselves fall within the claims. The respondent likewise finds something in the *Bassick* and *Lincoln* cases to limit them only to instances in which the patentee endeavors to embrace within his patent more than in equity and good conscience he is entitled to do (see Respondent's Brief p. 10).

The fact that the Judges of the Court of Appeals and respondent's counsel find such a limitation in the *Bassick* and *Lincoln* cases makes it clear that there is need for clarification. If the rule is not clarified, the decision of the Court of Appeals in this case will be good authority for the imposition of a greatly narrowing and restricting rule on the *Bassick* and *Lincoln* cases.

We believe that there was no intent in the *Bassick* and *Lincoln* cases to limit the rule as the Court of Appeals has done in this case. We believe that this Court intended to proscribe any extension of monopoly such as a patentee obtains when he claims an old combination with a new element therein. We believe that if the plaintiffs in the *Bassick* and *Lincoln* cases had brought action against the ultimate users of the patented combination, the result would have been the same. This Court would not countenance an extension of monopoly in an old combination to one who has merely improved one element.

### **There Is An Attempt to Extend Monopoly Here**

On page 3 of its brief, the respondent states that it does not have a patent which is to expire soon whose protection it seeks to extend with a patent on minor improvements. The respondent overlooks the fact that it was, when suit was filed, operating under an exclusive license under Moody patent 1,460,428 (R. V. II, p. 678) (now expired), and Moody patent 1,578,843 (R. V. II, p. 692) (which expires March 30, 1943). These two Moody patents give the respondent broad protection on the combination and the invention of the patents in suit lies merely in improving the vanes and not the combination.

### **The Hagen Invention Lay Merely in Improving the Vanes**

It is impossible to escape the conclusion that Hagen's only contribution lay in his design of the vanes. The Court of Appeals made this clear in its original opinion where it stated that Hagen's contribution was a mechanism for controlling the output of a centrifugal fan by means of vanes (R. V. III, p. 812). This was emphasized in the opinion rendered after the first rehearing (R. V. III, p. 824). It is fully backed up by the Master's specific findings referred to on pages 17-18 of Petitioner's Brief filed with the Petition for Writ of Certiorari.

The respondent contends on pages 12-15 of its brief that Hagen's invention was a combination, but it is clear even from the quotations there made that Hagen's invention was directed to improving the vanes only.

It is suggested on pages 10-11 of respondent's brief that Hagen's improved vanes made a new combination because they worked better than the old vanes used by Eickhoff

(R. V. II, p. 670), Moody (R. V. II, 678), Beaudrey (R. V. II, p. 765), and Brown-Boveri (R. V. II, p. 747). The fact that the vanes were improved would, of course, give improved results, but these improvements are none the less merely improvements in vanes. They do not change the operation of the motor, or the operation of the fan. The motor merely drives the fan and the fan merely moves the air.

The Master, the District Court and the Court of Appeals all agree that Hagen's contribution was merely an improvement in vanes. The subsidiary findings all point to this. The only suggestion that this is not the case lies in the very general and confused statement made by the Court of Appeals in its final modification of its opinion on rehearing (R. V. III, p. 828).

The formation of and mounting of the vanes for a wider range of movement was an improvement in vanes. The curving of the vanes to make them approach parallelism and form passages of substantially uniform cross section was an improvement in vanes. The formation of the vanes to eliminate throttling was an improvement in vanes. These improvements were what led to the more predictable results. The Hagen vanes performed the function of the prior art vanes but did it more efficiently. They did not change the construction or operation of the fan or motor in any way.

**The Decision of the Court of Appeals Does Conflict  
With a Large Body of Cases**

The first Hagen patent was broad enough to cover either the specific form of vanes shown in the patent (R. V. II, p. 574) or the form of vanes shown in the second Hagen patent (R. V. II, p. 586) provided the vanes were adjustable from open to closed position to give the full range of spin control. Hagen thus had a monopoly in both types of vanes. This monopoly granted under his first patent expires February 23, 1949.

In the second patent Hagen has an overlapping monopoly. It covers the form of vanes shown in the second patent and also covered in the first one. This monopoly does not expire until January 29, 1952.

Hagen obtained his second monopoly by merely adding as elements unpatentable mechanical details which had already become well known in the art through Moody and others. He merely combined with the subject matter of his first patent these unpatentable details so that the claims of the second patent would have additional elements in them.

The Master and District Court both saw that the same inventive concept had to support both patents and they ruled that the second patent was invalid because of the first patent and the prior art which showed the unpatentable details.

The Court of Appeals took the view, however, that since the applications for these patents were co-pending, it was immaterial whether there was any patentable distinction between the first and the second patent.

This is in direct conflict with the decisions cited by petitioner on page 26 of its brief in support of the Petition

for Writ of Certiorari. In practically every one of these cases, the inventor had obtained a patent for an invention. He had then applied for another patent in which he relied upon the inventive concept of his first patent and merely added non-inventive elements. In every instance, he was denied a second patent on the theory that one invention will support only one patent.

The respondent contends in its brief that there is no conflict between the decision of the Court of Appeals in this case and the cases cited by petitioner. The respondent contends that in the cited cases the applicant for patent was trying to get another patent for the identical invention. That is not the case. In every one of the cases cited, the applicant for patent had added some element to the invention of his prior patent. The added element was either mechanical or chemical or related to use, but in every instance the terminology of the claims differed materially. In every instance, however, the same inventive concept had to be relied upon to establish patentability.

In the present case, Hagen had the concept of making vanes of a certain form to give certain results and the concept of adjusting them from maximum to minimum. He obtained a patent therefor and then in his second patent, he merely modified the claims to this same invention by adding unpatentable mechanical details which are disclosed in the Moody patents. These details were old and well known and the man skilled in the art would have applied the first Hagen invention to the type of vane shown in the second Hagen patent without exercising any invention. The second patent, however, forecloses him from doing this. Even after the expiration of the first Hagen patent, he will not be able to use its principles in all of the well known vane forms and mountings because the second patent has set aside this territory as a monopoly for an additional period of time.

Both the Master and the District Court saw that the effect of the second Hagen patent was to extend the monopoly of the first patent in a field which was well known and adequately covered in the first patent. They saw that to sustain the second patent would be to extend the monopoly without calling upon Hagen for any further inventive acts than he had performed to obtain his first patent.

### Conclusion

It is submitted that the petition sets forth special and important reasons justifying this Court in granting a review on writ of certiorari. The Court of Appeals has either rendered a decision contrary to the decisions of this Court in the *Bassick* and *Lincoln* cases or has decided a question of Federal Law which should be decided by this Court and which has not been so decided and has decided it contrary to controlling authority. The Court of Appeals has also decided a question raised under the second Hagen patent in a manner in conflict with a large body of important decisions and, we submit, contrary to the basic principles of patent law. This Court should resolve the conflict.

It is respectfully urged that the petition be allowed.

Respectfully,

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